

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action mailed September 12, 2008, in which claims 1-3 and 5-13 were rejected.

Claims 1-3 and 5-13 are pending in the application. Claims 1-32 were originally presented. Claims 4 and 14-32 were withdrawn from consideration in a previous action. Applicant proposes to amend independent claims 1 and respectfully requests reconsideration of the application as amended herein. The subject matter of the amendments is found in the original specification and drawings, and no new matter has been added.

Claim Rejections -- 35 U.S.C. § 103

1. Obviousness rejection based on United States Patent No. 6,231,104 to Roethel in further view of United States Patent No. 4,655,497 to Mallett.

Before discussing the obviousness rejections of the present invention, Applicant would like to reiterate the standards for establishing a *prima facie* case of obviousness. The issue surrounding a rejection under § 103 is whether the PTO has stated a case of *prima facie* obviousness. Indeed, "the PTO has the burden under § 103 to establish a *prima facie* case of obviousness." In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To satisfy this burden, the PTO must meet the criteria set out in M.P.E.P. § 706.02(j):

... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Moreover, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and

the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

The Supreme Court recently clarified obviousness standards by stating that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (S. Ct. 2007).

Furthermore, “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (S. Ct. 2007) citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

Claims 1-3 and 5-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,231,104 to Roethel (hereinafter referred to as “Roethel”) and United States Patent No. 4,655,497 to Mallett (hereinafter referred to as “Mallett”). Applicant respectfully traverses this rejection because the PTO has failed to establish a *prima facie* case of obviousness.

With regards to amended independent claim 1, it is respectfully submitted that the teachings of Roethel and Mallett, taken individually or collectively, fail to teach or suggest all of the limitations recited in the claim as currently amended. More specifically, the combination of Roethel and Mallet fails to teach or suggest “a self-supporting modular fairing frame member comprising multiple support members that slidably mate end-to-end to comprise a common longitudinal axis upon interconnection ...”, as recited in claim 1 as amended herein.

Roethel teaches a frameless and flexible lightweight removable shield that is anchored to and supported at the upper end by the handlebars and at the lower end by the fender/fork of the motorcycle or bicycle. (see Roethel, FIG. 3; Col. 4, lines 40-48 and Col. 5, lines 58-52.). The attachment device of Roethel is comprised of elastomeric cords 125 (such as bungee cords) that are run through hollow casings 130 formed along the outer edges of the shield 10. The elastomeric cords 125 have hooks 120 at both ends which serve to attach the shield to the

motorcycle's handlebars 80 or the front fender/fork 70, 30. As illustrated in FIG. 2, the elastomeric cords can run through casings positioned along the upper and lower edges of the flexible material. (Col. 4, lines 17-39). Alternatively, as illustrated in FIG. 3, the elastomeric cords can run through casings positioned along the side edges of the flexible material. (Col. 4, lines 40-48). Applicant respectfully asserts, however, that at no point does Roethel teach a "self-supporting modular fairing frame member", let alone a modular fair frame member with "multiple support members that slidably mate end-to-end to comprise a common longitudinal axis upon interconnection."

In the rejection, the Examiner has again stated that the elastomeric cords 125 constitute a fairing frame member that at least partially defines a shape for the fairing. (see Office Action, page 3). Applicant respectfully disagrees, and asserts that the elastomeric cords cannot comprise a self-supporting modular fairing frame member within the meaning of the specification of the present invention nor within the understanding of one of skill in the art. For example, as taught in the specification of the present invention, the fairing frame member 120 forms a skeletal outline to which the fairing cover 150 can be attached to and/or wrapped around to form the modular fairing 110. (see Salisbury, FIGS. 1-3; Page 4, lines 9-15 and Page 6, lines 16-22). Therefore, the modular fairing 110 already has a self-supporting shape and form prior to installation to the front portion of the motorcycle 100. (Page 7, lines 15-17). In contrast, flexible shield 10 of Roethel is not self-supporting, and has no form or shape prior to being stretched across the front of a motorcycle of bicycle, and "upon removal ... can be folded up and placed with a saddle bag or in any other convenient location." (see Roethel, Col. 5, lines 61-64). Consequently, Roethel fails to teach or suggest the limitation of a self-supporting modular fairing frame member, as recited in amended claim 1.

Applicant acknowledges, however, that the secondary reference Mallet cited by the Examiner does teach a self-supporting fairing frame 56 comprised of vertical, spaced-apart medial members 60 connected by a lateral extending brace 62 and a series of horizontal semi-circular C-shaped ribs 64, 65, 66, and a vertical brace 70 connecting the midpoints of each of the ribs. (see Mallet, FIG. 1; Col. 3, lines 31-50). However, Mallet fails to teach or suggest that the frame 56 is comprised of "multiple support members that slidably mate end-to-end to comprise a common longitudinal axis upon interconnection ..."

There is no mention in the written disclosure of Mallet at all pertaining to the way in which the frame components are to be attached to each other. However, the figures do provide some additional insight with respect to the way the frame is configured. Namely, FIGS. 1-5 suggest that structural members 60, 62, 64, 65, 66 and 70 are all made from flattened bar stock and have rectangular cross-sections. These structural members appear to be placed side-to-side (or flat-to-flat) and attached together with fasteners, rivets or welding (*see* connection between medial members 60 and ribs 66, 64 and 64 in FIG. 1). Similarly, the ends of the lateral-extending brace 62 appear to have bent into L-brackets prior to attachment with fastener or rivets to the vertical medial members (*see* circular dots at either end of brace 62 in FIG. 4). Moreover, it is clear from the figures that each joint comprises the end of one structural member attaching to the mid-span of another structural member in a substantially 90 degree, side-to-side connection.

At no point, however, does Mallet or Roethel, separately or in combination, teach or suggest that the various support members forming the skeletal frame slidably mate end-to-end to comprise a common longitudinal axis upon interconnection, as recited in claim 1 and taught by the present invention. For instance, the skeletal frame 120 of the present invention can be formed from a middle portion 122, side portions 124, 126 and intermediate portions 128 having end portions 142, 146 that can be separated and re-joined end-to-end in a mating arrangement, in which an insert portion 144 can be slidably positioned within and removed from a tubular opening 148. (*see* Salisbury, FIGS. 2, 2(a); Page 4, lines 27-31 and Page 5, line 25-page 6, line 7). Furthermore, because each of the various support members connected end-to-end, the joined members comprise a common longitudinal axis upon interconnection. (*Id.*).

Consequently, Application respectfully submits that the combination Roethel and Mallet fails to teach or suggest all of the limitations recited in independent claim 1 as amended herein, which now stands in condition for allowance. Additionally, Applicant further asserts that claims 2-3 and 5-13 are also allowable as depending either directly or indirectly from allowable independent claim 1.

Based on the foregoing, Applicant submits that the prior art does not render the claims of the present invention obvious, particularly as amended to recite more specific and definite limitations. As such, Applicant respectfully requests that the claims of the application be reconsidered and that the rejection under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the deficiencies in the application have been corrected and that the proposed claims are neither anticipated nor rendered obvious by the prior art references cited by the Examiner. As such, Applicant believes that the application is now in a condition for allowance, and action to that end is respectfully requested.

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 20-0100.

DATED this 12th day of December 2008.

Respectfully submitted,

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